

REMARKS

In the Office Action, claims 1-4 and 6-52 were rejected by the Examiner. More particularly, claims 1-4 and 6-50 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter, claims 1, 5, 6, 8, 10, 11, 14, 15, 22-24, 28-31, 39-41, and 44-50 were rejected under 35 U.S.C. § 102(b) as anticipated by “Wisconsin Business, Insurers Take New Look at Wellness Programs” (“Wallenfang”), claims 2-4, 7, 9, 12, 13, 16-21, 25-27, 32-38, 42, and 43 were rejected under 35 U.S.C. § 103(a) as obvious over Wallenfang in view of various other references, and claims 51 and 52 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent Number 6,454,705 (“Cosentino”) in view of Wallenfang.

Upon entry of this Response, claims 1-4 and 6-52 will be pending. Claims 1, 40, and 51 have been amended. For the reasons set forth below, Applicant requests that the above-listed rejections be withdrawn.

Rejections under 35 U.S.C. § 101

The Examiner rejected claims 1-4 and 6-50 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant has amended claim 1 to recite a specific machine. In particular, Applicant has amended claim 1 to require that the “scoring, ranking, or grading” step be performed “using a computer.” This amendment is supported by, *e.g.*, paragraph [0100]. Applicant submits that claim 1 is now tied to a particular machine, and is therefore patentable under *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008). For the reasons cited above, Applicant respectfully requests the reconsideration and withdrawal of the rejections of claims 1-50.

Rejections under 35 U.S.C. §§ 102 and 103

The Examiner rejected claims 1, 6, 8, 10, 11, 14, 15, 22-24, 28-31, 39-41, and 44-50 under 35 U.S.C. § 102(b) as anticipated by Wallenfang, claims 2-4, 7, 9, 12, 13, 16-21, 25-27, 32-38, 42, and 43 under 35 U.S.C. § 103 as obvious over Wallenfang in view of various other references, and claims 51 and 52 under 35 U.S.C. § 103(a) as obvious over Cosentino in view of Wallenfang.. Applicant traverses these rejections.

Applicant has revised independent claims 1 and 51 to require that the “incentive program provides for an incentive for improving a Health Score.” Applicant submits that no reference

cited by the Examiner discloses this limitation.

The Examiner, at page 3 of the Final Office Action, states that Wallenfang discloses providing an incentive for “achieving a predetermined health score.” Wallenfang, however, nowhere discloses providing an incentive to achieve a health score. The extent of Wallenfang’s disclosure in this area is limited to “[i]f they score favorably, [the incentive] goes up to \$338.” This is an incentive for achieving a “favorable” *initial* wellness score. This is not an incentive for improving a wellness score. Wallenfang does not disclose, for instance, creating a second, later, wellness score and providing incentives for improvements in the second health score.

Applicant has also amended claim 40 to further specify that “the step of completing the health risk assessment questionnaire or the biometric measurement analysis or providing the biosample for biomedical analysis” be used for “categorizing the participant under assessment for purposes of enrollment in a clinical trial *for a disease therapy*.” This amendment is supported by, *e.g.*, paragraphs [0059] and [0080] of the specification. Applicant submits that no reference cited by the Examiner discloses this limitation.

The Examiner, at pages 3-4 of the Final Office Action, appears to identify the University of Michigan testing as the “clinical trial” on which the claim reads. The University of Michigan testing was not, however, a trial for any sort of disease therapy or treatment. The testing simply sought to correlate health risks to medical costs.

For the reasons cited above, and because the other references cited by the Examiner do not remedy the above-referenced deficiencies of Wallenfang, Applicant submits that claims 1, 40, and 51 are allowable over Wallenfang. Claims 2-4, 6-49, and 52 are believed allowable at least by virtue of their dependence from claims 1 or 51. Applicant respectfully requests the reconsideration and withdrawal of the rejections of claims 1-4 and 6-52.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding objections and rejections. There being no other rejections, Applicant respectfully requests that the current application be allowed and passed to issue.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this Response, or credit any overpayment, to deposit account no. 13-0019.

Respectfully submitted,

/Joseph A. Mahoney/

Joseph A. Mahoney

Reg. No. 38,956

CUSTOMER NUMBER 26565

MAYER BROWN LLP

P.O. Box 2828

Chicago, IL 60690-2828

Telephone: (312) 701-8286

Facsimile: (312) 706-9000